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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,610	04/21/2006	Toshio Yamauchi	0969-0187PUS1	2059

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BIRCH STEWART KOLASCH & BIRCH  
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EXAMINER
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MORGAN, EMILY M

ART UNIT	PAPER NUMBER
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3677

NOTIFICATION DATE	DELIVERY MODE
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05/30/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,610	<b>Applicant(s)</b> YAMAUCHI, TOSHIO	
	<b>Examiner</b> EMILY M. MORGAN	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2-13 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of species A in the reply filed on May 5, 2008 is acknowledged. The traversal is on the ground(s) that the application is made under 371, and is subject to unity of invention rules rather than species restrictions. This is not found persuasive because examiner can properly reject the shared technical feature, and therefore a restriction of the applicant's admitted 15 embodiments is proper. For claims to share a special technical feature and thus share unity, the shared technical feature must be inventive. Since claim 1 is properly rejected, any shared technical features are not, by definition, inventive, and therefore the claims can be properly declared to have a lack of unity of invention. Applicant did not address the reference US 1066754 in relation to the inventive step, and also admits that the equivalent Japanese application has been rejected. Since a restriction is optional and not mandatory, the lack of restriction on the part of the Japanese Patent Office is not proof of having or lacking unity of invention. Any more than one embodiment presents a burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the surface of rotation" in line 10. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over patent 1066754 to Rison, in view of patent 4752105 to Barnard.

Regarding claim 1, Rison discloses a caster (figure) having first 19 and second 21 wheels disposed forward and back and an endless wrap-around member 22 wrapped around the first 19 and second 21 wheels, characterized in that the wraparound member 22 consists of a plurality of pieces (links, line 56) continuous in the circumferential direction, and permit the wraparound member 22 to bend along the first 19 and second 22 wheels. Rison does not disclose an outer section and an inner section on the wrap around member, which is shaped so that it cannot be depressed inside a surface of rotation.

Barnard discloses a traction device that is located on two wheels (figure 1). The wrap around member 12 has pieces 40, each piece being provided with an outer peripheral section and an inner peripheral section which are moveable independent of the adjacent pieces and the outer peripheral section is adapted to contact the outer peripheral sections of the adjacent pieces when the wrap-around member is pushed inside the surface of rotation by an external force, thereby preventing the wrap-around member from being depressed inside the surface of rotation in excess of a predetermined amount (shown in figure 2). Since the outer edges of the pieces 40 touch when flat, as shown in figure 2, this allows for no inward deflection. Inward deflection would require further lateral compression of the outer edges, but the shape of the disclosed pieces 40 does not allow for any further indentation. The pieces are shaped in this fashion "to limit reverse bending of the track member under load" (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to place the track of Barnard on the caster of Rison, motivated by a change of use. Rison discloses that the wrap around member may not be ideal in other circumstances, and suggests changing the wrap around member for different conditions (line 60).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rison in view of Barnard as applied to claim 1 above, and further in view of patent 4995678 to Jinkens.

Rison in view of Barnard discloses the structure of claim 1, discussed above. Barnard discloses using a tensile element to connect the pieces, but does not disclose using a joint piece with pipe sections to connect the pieces.

Jinkens discloses a crawler track assembly that uses track pieces 23 having interlocking sections that mesh with the adjacent track piece, and are connected with pin 44, shown in figure 2.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the method of connecting track pieces as disclosed in Jinkens in the track of modified Rison, motivated by using a simple well known method to flexibly connect track pieces. The method of Jinkens is well known in the continuous track field to connect tracks. It would be an obvious design choice to replace the tension cord 41 of Barnard with the links of Jinkens, motivated by the desire to allow smaller maintenance problems. Should the tension cord of Barnard break, the whole piece must be rethreaded through the track pieces. Should the pin of a Jinkens track come out, only a single pin is needed to repair the entire track.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY M. MORGAN whose telephone number is

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(571)270-3650. The examiner can normally be reached on Monday-Thursday, alternate Fri, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Emm  
/EMM/

/Victor Batson/  
Supervisory Patent Examiner, Art Unit 3677